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SEP 04 2007

**OFFICE OF PETITIONS**

In re Application of	:	
Frederick L. Bixler, Doug	:	DECISION ON PETITION
Coners, and Don Rochow	:	PURSUANT TO 37 C.F.R.
Application No. 10/752,074	:	\$ 1.183 AND TWO RENEWED
Filed: January 5, 2004 <sup>1</sup>	:	PETITIONS PURSUANT TO 37
Title: TAMPER INDICATING	:	C.F.R. §§ 1.47(A) AND
CLOSURE WITH FOLDABLE TAB	:	1.48(A)

This is in response to the petition under 37 C.F.R. § 1.183 and the two renewed petitions under 37 C.F.R. §§ 1.47(a)<sup>1</sup> and 1.48(a)<sup>2</sup>. Each of these three petitions was filed on August 8, 2007.

1 A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee as set forth in 37 C.F.R. §1.17(g);
- (2) the surcharge as set forth in 37 C.F.R. §1.16(e), if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
  - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
  - b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;
- (5) a declaration which complies with 37 C.F.R. § 1.63.

2 A grantable petition under 37 C.F.R. §1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her

Original petitions pursuant to Rules §§ 1.47(a) and 1.48 were filed on May 8, 2007. A single decision dismissed each of these petitions was mailed on June 25, 2007.

The petition pursuant to Rule § 183 is **DISMISSED**.

The renewed petition pursuant to Rule § 1.47(a) is **DISMISSED**.

The renewed petition pursuant to Rule § 1.48(a) is **DISMISSED**.

On January 5, 2004, the application was filed, identifying Frederick L. Bixler, Doug Coners, and Don Rochow as joint inventors. The application was deposited without an executed declaration. On October 7, 2004, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice) was mailed, requiring, *inter alia*, a fully executed oath or declaration and the surcharge associated with the late submission of the same. This Notice set a two-month period for reply.

On May 12, 2005, a partially executed declaration was provided to the Office, along with the surcharge associated with the late submission of the same, and a five-month extension of time. It is noted that the submission contains a certificate of mailing dated May 9, 2005, and that May 7, 2005 fell on a Saturday.

With the present submission, Petitioner has included an **acceptable declaration** that has been signed by David Krueger and Frederick Bixler, along with a request to add Mr. Krueger as a joint inventor.

The petition pursuant to Rule § 1.183:

Regarding the petition under 37 C.F.R. § 1.183, Petitioner has requested that the requirements of 37 C.F.R. § 1.48 (a)(3) be waived. Rule § 1.48 (a)(3) requires the submission of an oath or declaration by the actual inventor or inventors. As set forth on original petition pursuant to Rule § 1.47, Petitioner wishes to add David F. Krueger as an inventor. With the original petition, Petitioner supplied the required statement, and this document was

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part;

- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

executed by each of these individuals save Messrs. Coners, and Rochow.

With this latest submission, Petitioner has asserted that Mr. Coners was located, and that a complete copy of the application was provided to him, however he has refused to execute the declaration. Petitioner has further set forth that Mr. Rochow cannot be located.

Petitioner has established that Mr. Coners has refused to execute the declaration.

As for Mr. Rochow however, Petitioner will note that **the decision on the original petition pursuant to Rule 47(a) discussed the need for a description of the search**, on pages 2-3 of the decision:

Regarding the fourth requirement of Rule § 1.47(a), Petitioner has suggested that neither Mr. Coners or Mr. Rochow can be located, and that Petitioner has been "unable to locate a current telephone number, e-mail address and mailing address for either of them<sup>3</sup>."

It does not appear that Petitioner has provided any **details of the efforts to obtain this information**. Petitioner must provide a showing detailing the attempts that were made to obtain a forwarding address or to locate the non-signing inventor by means such as through E-mail, telephone, or the Internet. If it is then averred that such attempts failed, then applicant will have provided the necessary proof required under 37 C.F.R. § 1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details.

Emphasis included.

With this latest submission, it appears that **Petitioner has again failed to describe the search**, provide a showing detailing the attempts that were made to locate Mr. Rochow, or provide a print-out of either the search terms or the search results.

It follows that since it cannot be determined if the search was a diligent effort to locate Mr. Rochow, the petition pursuant to Rule § 183 must be dismissed, as it has not been established that the present situation comprises an extraordinary situation such that justice requires the waiver of Rule § 1.48(a)(3).

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<sup>3</sup> Helfert declaration.

The renewed petition pursuant to Rule § 1.47(a):

As set forth above, Petitioner has **failed to provide details of the efforts to locate the non-signing inventor**, and as such, the petition pursuant to Rule §1.47(a) must be dismissed.

The petition pursuant to Rule § 1.48(a):

Petitioner has provided a request to correct the inventorship that sets forth the desired inventorship change, along with a statement from the person being added as an inventor. However, Petitioner has **failed to comply with Rule §1.48(a)(3)**, and pursuant to the discussion above, this requirement has not been waived.

Consequently, the petition pursuant to Rule § 1.48 must be dismissed.

#### CONCLUSION

Any renewed petition must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.183 and Second Renewed Petition Under 37 C.F.R. §§ 1.47(a) and 1.48(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

The submission should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail<sup>4</sup>, hand-delivery<sup>5</sup>, or facsimile<sup>6</sup>. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web<sup>7</sup>.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

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4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

7 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225<sup>8</sup>. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski  
Senior Attorney  
Office of Petitions  
United States Patent and Trademark Office

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<sup>8</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.